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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,143	07/23/2001	Hidenori Wada	10873.772US01	4482

7590 05/26/2006

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT PAPER NUMBER

2627

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,143

Applicant(s)

WADA ET AL.

Examiner

Jorge L. Ortiz-Criado

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/13/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 34 recites the limitation “said administrative information of the optical recording medium including at least one of a recording and reproducing condition of the optical recording medium”. The examiner cannot readily ascertain where in the specification as originally filed such a disclosure/support is found. Furthermore, the examiner cannot find what or how the Applicant defines administrative information. The Applicant suggested that the support for this limitation is found in page 28 lines 14-19 and in page 29 lines 27-31. However, the examiner cannot concur, because none of this portions or any other part of the specification discloses any administrative information that includes recording and reproducing condition of the optical recording medium. Given the broadest reasonable interpretation in view of the supporting disclosure the administrative information is information recorded in one of the layers of the disk.

The limitation is considered new matter.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 34 is rejected under 35 U.S.C. 102(e) as being anticipated by Kashiwagi U.S. Patent No. 6,175,548.

Kashiwagi discloses an optical recording medium comprising, a base substrate (10), a cover layer (12) through which a laser beams is passed with a wavelength of 390nm to 420 nm, a first recording layer (11B) on which signals are recorded or reproduced with a laser beams having a wavelength of 390nm to 420 nm; and

a second recording layer (11A) on which signals are recorded or reproduced with a laser beams having a wavelength of 390nm to 420 nm,

the first recording layer having recorded thereon “administrative information” of the optical recording medium including at least one of a recording and reproducing condition of the optical recording medium (The first and second layer are “information recording layers”, hence having recording thereon information); and

a distance from a surface of the optical recording medium on which the laser beam is incident to the first recording layer is $100\text{ }\mu\text{m} \pm 10\mu\text{m}$ (See col. 1, line 59 to col. 2, line 36; col. 3, line 64 to col. 4, line 41; Figure 2).

Response to Arguments

Applicant's arguments filed 03/13/2006 have been fully considered but they are not persuasive.

Applicant argues that Kashiwagi does not disclose "administrative information of the optical recording medium including at least one of a recording and reproducing condition of the optical recording medium.

The Applicant suggested that the support for this limitation is found in page 28 lines 14-19 and in page 29 lines 27-31. However, the examiner respectfully disagrees, because none of this portions or any other part of the specification discloses any administrative information that includes recording and reproducing condition of the optical recording medium. This limitation is considered new matter. For purposes of examination the examiner has given the broadest reasonable interpretation in view of the supporting disclosure the administrative information is information recorded in one of the layers of the disk.

Kashiwagi discloses a distance from a cover layer to the first recording layer is 100 mum. The examiner cannot find how the desired information recorded on the disk changes the structure of the recording medium being claimed. The limitation recited must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the desired use, which in this case is record "administrative information", as claimed, then it meets the claim. In this case, the claimed structure of the recording medium is met by Kashiwagi,

which records information thereon in any of the information recording layers of the recording medium.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

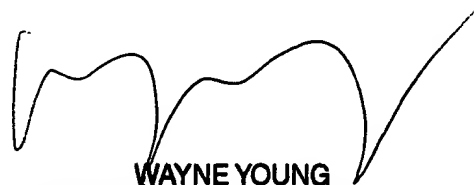
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-7624. The examiner can normally be reached on Mon.-Thu.(12:30 pm- 9:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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WAYNE YOUNG
SUPERVISORY PATENT EXAMINER